

REMARKS

Reconsideration of this application as amended is respectfully requested. Claims 1 and 35 have been amended, and claims 2 and 33 were previously cancelled. Accordingly, claims 1, 3-32 and 34-36 remain in this application and are again presented for the Examiner's consideration in view of the following comments.

Initially, applicant wishes to thank Examiner Steitz for the time and courtesy extended to applicant's undersigned counsel during the telephone interview conducted on July 29, 2009. During that interview, applicant's counsel pointed out that *Anakama* fails to teach or suggest that the rod and brush of the applicator are spaced from the inner wall of the receptacle in the assembled condition, whereupon the Examiner contended that this would be obvious at small angles between the rod and brush. In addition, the propriety of combining *Anakama* with *Anderson* was discussed, as were the deficiencies in the Rule 132 Declaration of Jean-Louis Gueret which was submitted with applicant's last response. No agreement was reached on the allowability of the claims herein, but the Examiner agreed to further consider applicant's arguments upon the submission of an appropriate response to the most recent Official Action.

In the Official Action, claims 1, 3-26, 29-32, 34 and 35 were rejected under 35 U.S.C. § 103(a) as being obvious over Japanese Patent No. 55-136409 to *Anakama* ("Anakama") in view of U.S. Patent No. 5,918,994 to Gueret ("Gueret I") and U.S. Patent No. 3,343,551 to *Anderson* ("Anderson"). Applicant respectfully traverses this rejection.

Applicant initially notes the requirement in claim 1 for

said twisted-wire core being bent such that substantially all points of said bristle-carrying portion form an angle greater than 0° and less than about 20° relative to said longitudinal axis of said end portion of said rod.

As applicant has noted in its prior response, neither *Anakama* nor *Gueret I* teaches or suggests this limitation. While *Anderson* teaches an angle of 0°-60°, nothing in any of the references suggests a range of angles of greater than 0° and less than about 20° as set forth in claim 1. The Examiner has contended that such range would be obvious to one skilled in the art since the general conditions are disclosed in the prior art and the claimed range is merely an optimization. Applicant disagrees. In order for the optimization of a parameter to be characterized as routine experimentation and hence obvious, that parameter must first be recognized as a result-effective variable. MPEP 2144.05, citing *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (CCPA 1977). Nowhere does the art of record suggest in any way that the angle of the bristles relative to the rod is a result-effective variable for the amount of material retained on the bristles. For this reason, applicant respectfully disagrees with the Examiner's contention that an angle of greater than 0° and less than about 20° would have been obvious to one of skill in the art.

Applicant would next direct the Examiner's attention to the requirement in claim 1 that

said rod and said brush being spaced from said inner wall in said assembled condition.

Applicant respectfully submits that neither *Anakama*, *Gueret I* nor *Anderson*, alone or in combination, teaches or suggests this feature.

As applicant has noted in a prior response, *Anakama* teaches that the bristle portion of the applicator is oriented at an angle of about 30° with respect to the wand portion of the applicator (*Anakama* translation, pg. 7 of source.) However, nothing in the reference suggests that the rod and the brush of the applicator are spaced from the inner wall of the receptacle in the assembled condition as required by the foregoing limitation. During the aforementioned telephone interview, the Examiner stated that she relied for this teaching on page 8 of the *Anakama* translation which states that "the applicator wand (2) and the applicator bristles (3) can be brought out smoothly, without dragging or catching on anything at all." However, contrary to the Examiner's contention, this statement does not teach that the rod and the brush of *Anakama* are spaced from the inner wall of the receptacle. Rather, the portion of *Anakama* in question actually refers to the oval insertion opening (5) which facilitates removal of the brush from the receptacle when the bristles are properly aligned with the insertion opening during removal. This teaching is not the same as teaching that, when in the assembled condition, the rod and the brush are spaced from the inner wall of the receptacle.

Neither *Gueret I* nor *Anderson* overcomes the deficiencies of *Anakama* discussed above. In that regard, *Gueret I* has been cited merely as teaching mascara brushes having a twisted wire core, non-circular cross-sections, longitudinal ribs, planar surfaces, concave surfaces, constant cross-sections, varying cross-sections, and cross-sections that vary in size, but not in shape. However, nothing in *Gueret I* suggests an applicator in which the bristle-carrying portion is oriented at an angle other than 0° relative to the longitudinal axis of the applicator rod. Consequently, *Gueret I* fails to teach an applicator having an angled bristle-carrying portion

which is spaced from the inner wall of its receptacle when the two are in the assembled condition.

Similarly, *Anderson* fails to provide this missing teaching. That is, *Anderson* fails to provide any disclosure of inserting an applicator into a narrow receptacle, and the disclosure that the angle between the handle and the bristle-carrying portion may be up to 60° suggests that *Anderson* does not contemplate insertion of the applicator into such receptacles. Indeed, *Anderson* refers to the application of any type of mascara, "including cake, liquid, cream and paste types." (*Anderson*, col. 3, lns. 47-49.) Such different forms of mascara would require receptacles of different types. However, regardless of the form of the receptacle, *Anderson* provides no teaching of the insertion of the applicator into the receptacle, and therefore simply cannot teach that the rod and the brush of the applicator are spaced from the inner wall of the receptacle in the assembled condition.

In view of the foregoing, applicant submits that claim 1 patentably distinguishes over *Anakama*, *Gueret I* and *Anderson*, either alone or in any combination which the Examiner contends can be made therefrom.

Additionally, applicant would direct the Examiner's attention to the requirement in claim 1 for

said receptacle having an inner wall and a wiper member configured to contact said brush during withdrawal of said brush from said receptacle.

Plainly, neither *Anakama*, *Gueret I* nor *Anderson* teaches such a wiper member which contacts the brush where the brush forms an angle of greater than 0° relative to the rod as required by claim 1.

*Anakama* clearly teaches away from this feature. That is, as noted above, *Anakama* plainly states that the provision of

an oval insertion opening enables the applicator wand and the applicator bristles to be brought out smoothly "without dragging or catching on anything at all." This is a clear teaching that the wiper member of *Anakama* is configured **not** to contact the brush as the brush is withdrawn from the receptacle.

Turning next to *Anderson*, nothing in the reference discloses anything about the receptacle containing the mascara, and certainly nothing in the reference provides any disclosure whatsoever about a wiper member in the receptacle. Accordingly, *Anderson* fails to overcome the deficiencies of *Anakama* noted above.

While *Gueret I* discloses a receptacle having a wiper member (*Gueret I*, Fig. 9 and col. 6, lns. 25-29), this teaching is in the context of a straight applicator, i.e. an applicator having an angle of  $0^\circ$  between the bristles and the rod. (*Gueret I*, Fig. 9.) Nothing in *Gueret I* suggests a bristle portion disposed at an angle to the rod, and therefore nothing in the references suggests that in such embodiment, a wiper member should be configured to contact the brush upon withdrawal of the brush.

Hence, nothing in any of the references relied upon by the Examiner suggests the provision of a wiper member configured to contact the brush upon withdrawal from the receptacle when the brush forms an angle greater than  $0^\circ$  relative to the applicator rod.

Moreover, it is clear from the disclosures of *Anakama* and *Anderson* that these references are directed to different types of mascara contained in different types of receptacles such that one of ordinary skill in the art would lack the motivation to combine the teachings of these references.

Rather than finding the motivation to combine the references in the prior art, the Examiner's rejection is a classic example of hindsight reconstruction in which the

Examiner has selected teachings from multiple prior art references to create the subject matter claimed by applicant using the applicant's specification as a "template." *Texas Instruments, Inc. v. US Int'l. Trade Comm'n.*, 988 F.2d, 1165, 26 USPQ 2d 1018 (Fed. Cir. 1993). The impropriety of such hindsight reconstruction is well settled. *Interconnect Planning Corp. v. Feil*, 744 F.2d, 1132, 227 USPQ 523 (Fed. Cir. 1985); *In re Fine*, 837 F.2d, 1071, 15 USPQ 2d 1596 (Fed. Cir. 1998). Although the recent Supreme Court decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007), rejected a "rigid application" of the "teaching, suggestion or motivation" test for combining reference teachings, the decision reaffirms the principle that there still must be an apparent reason to combine elements taught by plural references. No such reason is apparent here.

In the present case, *Anakama* teaches that an angle of about 30° is needed to keep the applicator rod away from the face of the user. In light of this teaching, it is improper to state that angles of 0-60° could be used on the basis of *Anderson*. In other words, simply because *Anderson* states that an applicator brush could include angles of 0-60°, it would totally disregard the teachings of *Anakama* to employ angles of less than about 30°. Thus, one seeking to improve upon the applicator of *Anakama* would have no reason to employ angles of less than 30° as taught by *Anderson*, as to do so would result in the very problem *Anakama* sought to avoid - applying mascara to the cheek or face of the user. Indeed, *Anakama* was aware of and improved upon straight applicators, namely those having angles of 0° which were already well known in the art. On this basis, the motivation to combine the teachings of *Anakama* and *Anderson* is entirely lacking.

Additionally, *Anakama* and *Anderson* are directed to different types of mascara held in different types of receptacles and using different types of applicator brushes. *Anakama* is directed to an applicator brush which fits inside of what is currently a conventional mascara container, while *Anderson* is simply directed to a brush for applying mascara, but not necessarily from a conventional container. That is, at col. 3, lns. 44-49, *Anderson* states that the brush may be used with any type of mascara, including "cake, liquid, cream and paste types." Thus, nothing in *Anderson* refers to the insertion of the brush into a conventional container of the type having a wiper member. It is only because it lacks this constraint that the brush of *Anderson* can have an angle of up to 60°. Plainly, an applicator brush with such a large angle could not be used with a conventional container, such as that of *Anakama*. As the applicator brushes of these two references are of different types, the teachings of one reference would not necessarily be applicable to the other. This is another reason why the skilled artisan would have no motivation to combine these teachings.

In view of the foregoing, applicant submits that claim 1 patentably distinguishes over the combination of *Anakama*, *Gueret I* and *Anderson* such as to warrant its immediate allowance, which action is respectfully requested.

Claims 3-26, 29-32 and 34-35 depend either directly or indirectly from claim 1 and include all of the limitations of that claim. For at least this reason, applicant submits that these dependent claims also distinguish patentably over the combination of *Anakama*, *Gueret I* and *Anderson* such as to warrant their immediate allowance, which action is respectfully requested.

In addition, applicant notes the following requirement in claim 4:

said bristle-carrying portion includes a middle and a distal end portion extending from said middle to a free end of said bristle-carrying portion, said longitudinal axis of said end portion of said rod intersecting said envelope surface of said distal end portion.

As is clearly evident, *Anakama*, *Gueret I* and *Anderson* are all silent with respect to this feature. This is another reason why applicant believes claim 4 distinguishes over these references.

Claim 10 requires the remote end of the core to be situated at a distance of less than about 7.5 mm from the longitudinal axis of the end portion of the rod; and claim 11 requires this distance to be less than about 4.5 mm. As nothing in either *Anakama*, *Gueret I* or *Anderson* suggests this structural relationship, applicant submits that this is an additional reason why claims 10 and 11 distinguish patentably over these references.

Claim 35 requires the wiper member to have an orifice of circular cross-section. As discussed above, *Anakama* teaches that the wiper member should have an oval opening so that the angled brush portion can be removed from the receptacle "without dragging or catching on anything at all." Hence, even if *Gueret I* were to teach a wiper member having an orifice with a circular cross-section, a skilled artisan would have no motivation to combine this teaching of *Gueret I* with *Anakama* as to do so would directly contradict the teaching of *Anakama* that dragging or catching on the wiper member is undesirable.

Claims 27, 28 and 36 have been rejected under 35 U.S.C. § 103(a) as being obvious over *Anakama* in view of *Gueret I* and *Anderson*, and further in view of U.S. Patent No. 5,462,798 to *Gueret* ("*Gueret II*"). This rejection is respectfully traversed in view of the above amendments and arguments and for the reasons set forth below.

Applicant would initially note that claim 36 includes the same limitation as claim 1 discussed above, namely, "said rod and said brush being separated from said inner wall in said assembled condition." As such, applicant would reiterate the contentions set forth above with regard to the manifest deficiencies of *Anakama*, *Gueret I* and *Anderson*, and in particular, in their attempted combination. *Gueret II* fails to overcome these deficiencies. Accordingly, applicant submits that claims 27, 28 and 36 patentably distinguish over *Anakama*, *Gueret I*, *Anderson*, and *Gueret II* such as to warrant their immediate allowance. In view of the foregoing, withdrawal of this rejection is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: October 22, 2009

Respectfully submitted,

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